

Appl. No. 09/585,186  
Amendment dated February 2, 2005  
Amendment to Office Action of 09/16/03

PATENT

REMARKS

Claims 44-64 are now pending. Prior claims 37-43 are canceled pursuant to a Restriction Requirement, without prejudice against pursuing these claims in a subsequent filed application. Prior claims 1-36 may have been cancelled and/or deleted in a Preliminary Amendment filed on November 29, 2000, and these cancelled claims may have subsequently been elected and examined in an Office Action dated September 16, 2003.

So as to clarify the status of the claims, applicants are herein canceling all prior claims and adding new claims, some of which correspond to prior examined claims 18-24, as explained below. Reexamination and reconsideration of the pending claims are respectfully requested.

Correspondence between Prior Claims 18-24 and Added Claims 44-49

To clarify the status of pending claims, applicants have cancelled and/or confirmed cancellation of all previously pending claims, including examined claims 18-24. To continue to seek patent protection for these examined claims, applicants are adding herein claims 44-49. Claim 44 is derived from prior claim 18, but includes the following amendments:

44. (as amended from prior claim 18) A method of controlling the position of a surgical instrument inside a patient's body the comprising steps of:

inserting a first surgical instrument into the patient's body, the instrument having a means for transmitting an image out of the patient's body;  
designating an anatomical feature of interest;  
transmitting an image of the designated anatomical feature out of the patient's body;  
determining precise 3D positional information about the designated anatomical feature of interest relative to the first surgical instrument;

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using the positional information to reposition the first surgical instrument to a desired positional relationship relative to the anatomical feature, where the positional information about the anatomical feature of interest relative to the first surgical instrument is obtained by manipulating a graphics object superimposed on an image of the anatomical feature.

The amendments to prior claim 18 effectively incorporate the subject matter of prior claim 20. Added claims 45-49 correspond exactly to the claim language of prior claims 19 and 21-24.

Restriction Requirement

Applicants hereby confirm the provisional election to prosecute the subject matter of prior claims 18-24 of Group I. Newly added claims 44-49 correspond to elected prior claims 18 (with amendments thereto), 19, and 21-24, respectively, as noted above. The non-elected claims have been canceled without prejudice against pursuing this subject matter in a subsequent application.

Objections to the Specification and Abstract

Applicants are providing a substitute Specification and have amended the Abstract per the request of the examiner. No new matter has been added. Removal of the formal objections is respectfully requested.

Rejections under 35 U.S.C. § 102

Prior claims 18 and 19 were rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by U.S. Patent No. 5,036,463 to Abela et al. Applicants have added claim 44, which corresponds to prior claim 18 as amended to include the elements of prior claim 20, so that this rejection is now moot.

Applicants note that the subject matter of prior claim 18 was amended solely to expedite prosecution of this application, rather than for reasons of patentability under the statutes or rules. Specifically, the rejection purportedly references the Abela et al. reference, but applies disclosure from U.S. Patent No. 5,402,801 to Taylor. As Applicants below are disqualifying the

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Taylor reference as prior art, the record lacks any requirement under the patent statutes or rules for these amendments.

Prior claims 18, 19 and 21 were rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by Taylor. Despite added claims 44-46 being derived from these prior claims, such a rejection is moot as follows:

Pursuant to § 706.02(i)(2) of the M.P.E.P., Applicants state the following:  
**The subject application (09/595,186) and US patent no. 5,402,801 to Taylor were, at the time the invention of the subject application (09/595,186) was made, owned by IBM (International Business Machines Corporation).**

Per § 706.02(i)(2) of the M.P.E.P., this is sufficient to disqualify the '801 Taylor patent from being used in a rejection under 35 U.S.C. § 103(a). Hence, the amended version of prior claim 18 now pending as claim 44 (and dependent claims which depend from therefrom) is in condition for allowance.

Claim Rejections under 35 U.S.C. § 103(a)

Prior claims 20 and 22-24 were previously rejected under 35 U.S.C. § 103(a) as allegedly being obvious over the Taylor '801 patent. As the Taylor '801 patent has above been disqualified as prior art, these rejections are now moot.

The Other Added Claims

Claims 50-64 have been added to more fully claim the present invention. No new matter has been added.

CONCLUSION

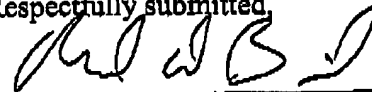
In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

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If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 650-326-2400.

Respectfully submitted,



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